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APPLICANTS: Jeff Haber
SERIAL NO.: 09/628,569
FILING DATE: July 31, 2000
TITLE: "Directing Internet Shopping Traffic and Tracking
Revenues Generated as a Result Thereof"
EXAMINER: Andrew J. Rudy
GROUP ART UNIT: 3627
ATTY. DKT NO.: 04910

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ALEXANDRIA, VA 22313-1450

REMARKS

Applicant herein provides this amendment/response in response to the
Official Action dated December 29, 2003.

Rejections Under 35 USC §103(a)

The Examiner has rejected claims 1-4, 9-11 and 16-20 under 35 U.S.C.
103(a) as being unpatentable over the article entitled "Mitsubishi Electric America
Teams with CyberSource to Market and Deliver Multimedia Software Via The
Web" (hereinafter referred to as "Mitsubishi") in view of Yeo et al. (U.S. Patent

No. 6,219,837) (hereinafter referred to as "Yeo"). Applicant respectfully traverses this rejection.

In making the rejection the Examiner mistakenly indicates that "Mitsubishi" discloses providing a segment of video content in a first portion of a display, simultaneously providing a product image in a second portion of the display and directly accessing a web page via a hyperlink to simultaneously retrieve a specific product information of the product or an option to complete on-line sales. This clearly overstates the disclosure of the "Mitsubishi" article.

The "Mitsubishi" article provided by the Examiner spans an entire two and one quarter pages. Having thoroughly read the article from front to back, Applicant can find only two references in Mitsubishi even remotely relevant to the claimed invention. Applicant will quote both of these passages verbatim so as not to provide any confusion.

First, "Mitsubishi" provides:

VisualSHOCK MOVIE is a leading-edge software component that *enables users to easily embed hyperlinks or "hotspots" into existing digital video*. Available only via electronic download at <http://www.visualshock.com>, VisualSHOCK MOVIE is aimed at professional presenters and Web site developers.

"Mitsubishi" further provides:

VisualSHOCK movie enables users to create interactive video content for presentations, Web pages or training. *A user can take an existing video file – an AVI, QuickTime or MPEG1 format – and create hotspots on that movie that hyperlink to other hot spots in the same*

movie, additional media, text, sounds, pictures, URLs, additional videos, and even executables. If an actor, for example, holds up a product in a video, clicking on a VisualSHOCK MOVIE-created hyperlink could take the viewer to a Web page with product information or online sales capabilities.

These passages clearly indicate that what "Mitsubishi" teaches is using special software to embed hyperlinks into "hot spots" on existing video content and then while watching the video content a user may click on those embedded hyperlinks or "hot spots" in order to jump to other media, including product information and online sales capabilities.

The Applicant has already acknowledged that this technology was known in the art at the time of invention. The invention as claimed, is significantly different from that which is taught by "Mitsubishi". For example, Claim 1 provides:

1. A method for providing internet traffic for on-line shopping:

providing a segment of video content in a first portion of a display, said segment of video having a number of products featured in the video content which a user may purchase;

simultaneously providing an image in a second portion of the display, which image corresponds with the segment of video content, the image being a select frame from said segment of video content and containing a number of user selectable areas, each user selectable area showing one of the products contained in the corresponding segment of video content, each user selectable area being anchored to a hyperlink, each hyperlink linking to an e-commerce website where specific information about the product resides and from which the product may be purchased;

receiving a user's selection of one of the areas in the image showing one of the products contained in the corresponding segment of video content;

using the hyperlink anchored to the user's selected area to directly access the e-commerce website and retrieve the specific information about the product contained un the corresponding segment of video content; and

simultaneously providing the specific information about the product to the user in a third portion of the display.

Similarly, Claim 16 provides:

16. A user interface for use with a web browser comprising:

a video area for displaying several contiguous segments of video content featuring products featured which may be purchased;

an image area for simultaneously providing a series of images, each image in the series corresponding with one of the contiguous segments of video content and being a select frame from said corresponding segment of video content, each image containing a number of user selectable areas, each area showing one of the products contained in the corresponding segment of video content, wherein each user selectable area in the image is anchored to a hyperlink which links directly to a sponsor webpage such that when the area is selected, information about the product show in that area, including an option to purchase, is linked directly from the sponsor webpage using the hyperlink, and the information is simultaneously displayed to the user in a third portion of the display.

Accordingly, unlike "Mitsubishi", the hyperlinks in the present invention are not embedded directly in the video. Instead, the hyperlinks in the claimed invention are anchored to the still images that correspond with the actual video content. As the video plays, the stills and the embedded hyperlinks are updated. A user may then click on products featured in a segment of video by clicking on the product in the still image. Using the hyperlink anchored to the selected area information about the product and purchasing the product will be displayed in a third area of the screen. This allows more than one product to be clicked on at a

time with much more ease and convenience while the video segment continues to play.

In a moving image – such as a video segment – the image is constantly moving and being updated. If there is more than one product in the video and a user wishes to purchase or obtain information about each product, he or she must act very quickly to click on both products as the video plays. Alternatively he or she must pause the video. One benefit of the claimed invention is that several products may be depicted throughout and over the course of a segment of video. This video is displayed in one portion or area of the screen display. Meanwhile, each of these products is also featured in a single still image, which is displayed in a separate portion or area of the screen display. Accordingly, a user can click on the featured products at a more leisurely pace as the video continues to play without having to stop the video. “Mitsubishi” does not teach this limitation.

Yeo (U.S. Patent No. 6,219,837) also does not hint teach or suggest these limitations. The Examiner states that items 20, 22 and 24 in FIG. 1 of Yeo disclose a plurality of video images placed in various portions of a display. However, Applicants are unclear as to how Yeo is relevant to their invention. Yeo discloses a main video segment that plays along at 18. The video itself is embedded with markers or summary frames. These summary frames depict key scenes from past video segments. As the video plays, these summary frames are displayed 20, 22,

and 24. If a user selects one of these scenes or summary frames (20, 22, or 24), the video jumps to the past video segment with which the summary frame is associated and the past segment of video is then played. The video is then rejoined back to where it left off – allowing a user to have a better sense of what occurred in the past. As Yeo clearly states, “when a channel surfer arrives at a new channel, rather than having only what is currently playing to catch the eye, summary frames are available to catch the surfer’s attention and aid in understanding the program.”

While Yeo may arguably be said to teach displaying images which correspond with video content, it does not teach embedding hyperlinks in these video images such that a user may click on these hyperlinks to jump to product information or on-line shopping capabilities which are then simultaneously displayed in a third and separate portion or area of the screen display. Rather, Yeo teaches embedding markers in a segment of video and then using still images to jump to certain portions of the video where these markers are embedded. Clearly this is not the same.

It is black letter law that in order to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the combined prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). Here the combination of “Mitsubishi” and Yeo is woefully lacking in teaching all of the elements of the claimed invention.

Finally, in order to establish obvious, it is incumbent upon the Examiner and the Office to show "that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988); *In re Lahu*, 747 F.2d 703, 705 (Fed. Cir. 1984); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 n. 24 (Fed. Cir. 1985); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). Here the Examiner has failed to provide any information as to how or why one of ordinary skill in the art would combine these references given their very different applications, objectives, goals and results.

In light of these facts, Applicant submits that neither "Mitsubishi", nor Yeo, nor their combination, teach all of the elements of the claimed invention. Accordingly, the rejection of claims 1-4, 9-11 and 16-20 under 35 U.S.C. 103(a) as being unpatentable over "Mitsubishi" in view Yeo should be withdrawn and the claims should be allowed.


The Examiner has further rejected Claims 5-8 and 12-15 under 35 U.S.C. 103(a) as being unpatentable over "Mitsubishi" in view of Yeo and in further view of Jammes (U.S. Patent 6, 484, 149). Applicants submit that each of these claims depends from an allowable independent claim, as previously discussed. Accordingly, these claims are also allowable.

Conclusion

Based upon the foregoing remarks, the Applicant respectfully submits that all of the claims in the instant application are in condition for allowance and the final rejection should be withdrawn and the claims allowed. Therefore, prompt reconsideration and allowance of all claims is hereby solicited.

Respectfully submitted

Date. February 27, 2004


John R. Carr
Reg. No. 42,390
Attorney for Applicant